

### REMARKS

Claims 1-16 were examined and reported in the Office Action. Claims 1-16 are rejected. Claims 1-16 are cancelled. New claims 17-26 are added. Applicant notes that new independent claims 17 and 22 clarify Applicant's invention. Claims 17-26 remain.

Applicant requests reconsideration of the application in view of the following remarks.

#### **I. 35 U.S.C. §103(a)**

A. It is asserted in the Office Action that claims 1-6 and 9-14 are rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 5,655,020 issued to Powers ("Powers") and further in view of U. S. Patent No. 5,941,947 issued to Brown et al ("Brown"). Applicant has canceled claims 1-6 and 9-14 and added new independent claims 17 and 22. Applicant respectfully traverses the aforementioned rejection regarding new claims 17 and 22 for the following reasons.

According to MPEP §2142 "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." (*In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991)). Further, according to MPEP §2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974))." "*All words in a claim must be considered in judging the patentability of that claim against the prior art.*" (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), emphasis added.)

Applicant's new claim 17 contains the limitations of "[a] method for processing confidential codes in a system having secure functionalities, said secure functionalities being accessible by a predetermined confidential code comparison process accessible to said system, the method comprising: providing a conversion scheme that a starting code to be converted into a converted code for a user to convert their confidential code into an emergency code, said conversion scheme having a reverse conversion scheme to convert said converted code into said starting code; receiving a confidential code inputted by a user; verifying a first user entitlement by performing the comparison process on said confidential code; if said first user entitlement is recognized, allowing access of the user to a first secure functionality; if said entitlement is not recognized, converting said inputted code into an alternate code by applying said reverse conversion scheme, verifying a second user entitlement by performing said comparison process on said alternate confidential code, if said second entitlement is recognized, allowing access of the user to a second functionality which is restricted relative to said first secure functionality, without providing any information on the fact that the inputted code failed to provide entitlement."

Applicant's new claim 22 contains the limitations of "[a] system comprising: means for inputting a confidential code; means for accessing a predetermined confidential code comparison process for entitling the user to secure functionalities, means for providing an inputted confidential code to said confidential code comparison process and for authorizing access to a first secure functionality if said comparison process results in entitlement, converting means for applying to said inputted code a conversion scheme that is a reverse of a given conversion scheme that allows a user to convert his confidential code into an emergency code, so as to obtain an alternate code, means for providing said alternate code to said comparison process and for authorizing access to a second functionality if said comparison process results in entitlement, without providing any information on the fact that the inputted code failed to provide entitlement."

Applicant's new independent claims 17 and 22 clearly assert that only one single code is input by a user, and that a second code is generated by the system itself if the

first code fails. Additionally, new independent claims 17 and 22 clarify that both codes go through the same comparison process, i.e. the code expected by the process is the same in both cases.

To assist in understanding the claimed invention, Applicant submits the following. Consider an example where a user has a bank card with the confidential code PIN which is "1234." The code comparison process compares any code input by the user with this "1234" value. If the code is correct, the user is entitled to a first secure functionality, for example: obtaining cash from an ATM. If a card owner is under threat by a thief who forces him to an ATM for obtaining cash and to check the accuracy of the PIN code of the card owner, the owner first converts (in his mind) the code "1234" into an alternate code, for instance "1233" according to a simple conversion scheme as indicated by his bank when providing the card. Once input on the keyboard, this "1233" code does not provide the first functionality entitlement. In that case, the system converts that figure back to the "1234" value (reverse conversion scheme), and this value is passed to the comparison process and succeeds, so that the second functionality entitlement is authorized.

For example, the second functionality entitlement, as described in Applicant's specification, could generate a message simulating for instance a system failure, or could even provide a small amount of cash. Therefore, the thief believes that the "1233" code is the correct code and goes away with the card and that code in mind. Thus, the threat to the card owner is substantially decreased.

Powers discloses an authenticating method that requires entry of two different codes, the second code being derived from the first by the user (himself/herself) before entry on the basis of a simple alteration, which is expected by the machine. The expected alteration is verified by the machine in order to authenticate the user and finally give a unique access to particular rights. Therefore, Powers discloses two comparison processes for two different codes, each code input by the user. Thus, the method disclosed in Powers can not be used in a process according to Applicant's

claimed invention, where only a single code input is sufficient to determine whether the code is the normal one or an emergency one.

Nowhere in Powers are the limitations of “verifying a first user entitlement by performing the comparison process on said confidential code; if said first user entitlement is recognized, allowing access of the user to a first secure functionality; if said entitlement is not recognized, converting said inputted code into an alternate code by applying said reverse conversion scheme, verifying a second user entitlement by performing said comparison process on said alternate confidential code, if said second entitlement is recognized, allowing access of the user to a second functionality which is restricted relative to said first secure functionality, without providing any information on the fact that the inputted code failed to provide entitlement” taught, suggested or disclosed.

Brown discloses access rights of users of a computer network with respect to data entities are specified by a relational database stored on one or more security servers. Application servers on the network that provide user access to the data entities generate queries to the relational database in order to obtain access rights lists of specific users. Brown, however, does not teach, disclose or suggest “verifying a first user entitlement by performing the comparison process on said confidential code; if said first user entitlement is recognized, allowing access of the user to a first secure functionality; if said entitlement is not recognized, converting said inputted code into an alternate code by applying said reverse conversion scheme, verifying a second user entitlement by performing said comparison process on said alternate confidential code, if said second entitlement is recognized, allowing access of the user to a second functionality which is restricted relative to said first secure functionality, without providing any information on the fact that the inputted code failed to provide entitlement.”

Therefore, even if the teachings of Powers were combined with that of Brown, the resulting invention would still not contain all of the limitations of Applicant’s claims 17 and 22. Since neither Powers, Brown, nor the combination of the two disclose, teach

or suggest all the limitations contained in Applicant's claims 17 and 22, as listed above, there would not be any motivation to arrive at Applicant's claimed invention. Thus, Applicant's claims 17 and 22 are not obvious over Powers in view of Brown since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from claims 17 and 22, namely claims 18-21, and 23-26, respectively, are also not obvious over Powers in view of Brown for the same reason.

Accordingly, withdrawal of the 35 U.S.C. §103(a) rejections for claims 1-6 and 9-14, as applied to new claims 17-26 are respectfully requested.

**B.** It is asserted in the Office Action that claims 7 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Powers and further in view of Brown, in view of U. S. Patent No. 4,774,500 issued to Lichty ("Lichty"). Applicant respectfully traverses the aforementioned rejection regarding new claims 17 and 22 for the following reasons.

Applicant has addressed Powers and Brown above regarding new claims 17 and 22.

Lichty discloses a data compaction method for writing data in compact binary form. The data compaction method is suitable for an account card having a limited, non-erasable memory used in an automated transaction terminal for maintaining an account record of transactions in frequently recurring amounts. A postage metering terminal is operated by the account card, in which an initial balance has been written and each purchase of postage is recorded. A current balance is recomputed by parsing the previously recorded data. If the current balance is sufficient, the requested value is recorded in compressed form in the card memory, and the terminal is operated to print or dispense the requested postage.

Similarly regarding Powers and Brown, Lichty does not teach, disclose or suggest "verifying a first user entitlement by performing the comparison process on said confidential code; if said first user entitlement is recognized, allowing access of the user to a first secure functionality; if said entitlement is not recognized, converting said

inputted code into an alternate code by applying said reverse conversion scheme, verifying a second user entitlement by performing said comparison process on said alternate confidential code, if said second entitlement is recognized, allowing access of the user to a second functionality which is restricted relative to said first secure functionality, without providing any information on the fact that the inputted code failed to provide entitlement.”

Therefore, even if the teachings of Powers and Brown were combined with that of Lichty, the resulting invention would still not contain all of the limitations of Applicant’s new claims 17 and 22. Since neither Powers, Brown, Lichty, nor the combination of the three disclose, teach or suggest all the limitations contained in Applicant’s claims 17 and 22, as listed above, there would not be any motivation to arrive at Applicant’s claimed invention. Thus, Applicant’s claims 17 and 22 are not obvious over Powers and Brown in view of Lichty since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from claims 17 and 22, namely claims 18-21, and 23-26, respectively, are also not obvious over Powers in view of Brown and further in view of Lichty for the same reason.

Accordingly, withdrawal of the 35 U.S.C. §103(a) rejections for claims 15 and 16, applied to new claims 17-26 are respectfully requested.

### CONCLUSION

In view of the foregoing, it is submitted that claims 17-26 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

### PETITION FOR EXTENSION OF TIME

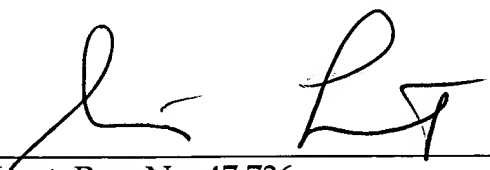
Per 37 C.F.R. 1.136(a) and in connection with the Office Action mailed on October 21, 2004, Applicant respectfully petitions the Commissioner for a one (1) month extension of time, extending the period for response to February 21, 2005. The Commissioner is hereby authorized to charge payment to Deposit Account No. 02-2666 in the amount of \$120.00 to cover the petition filing fee for a 37 C.F.R. 1.17(a)(1) large entity. A duplicate of Applicant's Fee Transmittal is enclosed.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated: January 28, 2005

12400 Wilshire Boulevard  
Seventh Floor  
Los Angeles, California  
90025  
(310) 207-3800

By:   
Steven Laut, Reg. No. 47,736

### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop A/F, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on January 28, 2005.

  
Jean Svoboda